

REMARKS

STATUS OF CLAIMS:

Claims 1-20 are pending in the application. Claims 15 and 16 are allowed. Claims 1-4, 6-8, 10-14, and 17-20 are rejected. Claims 5 and 9 are objected to.

CLAIMS 6 AND 18

The Examiner asserts that claims 6 and 18 are substantial duplicates. To address the Examiner's concern, Applicants amend claim 6 to depend from only claim 2.

35 U.S.C. § 103

The Examiner rejects claims 1-4, 6-8, 10, 14, 17-20 under 35 U.S.C. § 103(a) as being unpatentable over Yang et al. (U.S. Patent 6,848,691 [hereinafter "Yang"]).

Claim 1

Claim 1 recites, *inter alia*, "wherein the slotted portion is positioned above the concave engaging means in a state where a tip end of the jaw points downwardly." The Examiner acknowledges that Yang does not explicitly disclose this feature, but asserts that it would have been obvious because the Examiner contends that "it is a mere reversal of parts." (see page 3, last paragraph). This claimed feature is not a mere reversal of Yang's parts.

MPEP §2144.04 addresses reversal and rearrangement of parts and indicates that:

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis added.)

Yang explicitly notes in col. 5, lines 39-41 that, "the engagement of the drive slot 5-1 and the arms 7-1 causes the gear ring 6 to rotate as the front sleeve rotates." This is done when the

foot 7-2 engages the annular groove 5-2 and then falls into the slot 5-1. As a skilled artisan will appreciate, if the slot 5-1 were above the annular groove 5-2, the foot 7-2 would have a tendency to fall downwards into the annular groove. This would result with the gear ring 6 not rotating with the front sleeve. This is clearly not what Yang intended. Thus, besides the lack of any teaching to modify Yang, a skilled artisan would not be motivated to make such a modification because of the inherent poor design that would result.

Moreover, it has long been held that the Examiner must “show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453 (Fed.Cir. 1998). The mere fact that references can be “combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification].” *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01. There is clearly no motivation found in Yang for placing the asserted drive slot 5-1 (applied against claimed slotted portion) above the arm 7-1 or foot 7-2.

Accordingly, Applicants urge the Examiner to understand that Yang fails to teach or suggest each feature recited in claim 1. The rejection should be withdrawn. Claims 2-4, 6-8, 10, 14, 17 and 18 are also not obvious in view of Yang at least due to their respective dependencies on claim 1.

Claim 19

An exemplary “convex portion” of a present embodiment is shown as element 15 in Figure 3 and described in the last paragraph of page 4. This forms part of the “drive key” described on page 4, for example. However, the Examiner interprets the convex portion and concave portion of Yang to be part of the applied convex engaging means and concave engaging means (see page 3, lines 5-9 of the June 2, 2006 Office Action). Thus, to further define the claimed features, claim 19 is amended to describe the convex and concave engaging portion as providing a drive key and being separate from the convex and concave engaging means. These features contribute to the unique combination of elements in claim 19 and are not taught nor suggested by Yang, such that the rejection should be withdrawn.

Claim 20

Claim 20 is hereby amended to even further distinguish its features from Yang, by reciting that the slotted portion does not extend into the concave portion. For example, as shown in the exemplary embodiment of present Figure 3, the slotted portion is separate from 9a and does not extend into 9a. Yang does not disclose this feature because the applied slotted portion 5-1 of Yang is connected to and extends into the concave groove 5-2, as shown in Figure 1B of Yang, such that the rejection should be withdrawn.

35 U.S.C. §103 - claims 11-13:

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Owens et al. (U.S. Patent 5,465,983 [hereinafter “Owens”]). The Examiner applies Owens for allegedly disclosing a rotary sleeve made of a deformable plastic material.

Claim 12 is rejected under 35 U.S.C. §103(a) as being anticipated over Yang in view of Sakamaki et al. (U.S. Patent 6,659,474 [hereinafter "Sakamaki"]). The Examiner applies Sakamaki for allegedly disclosing a concave engaging means extending through a wall 18 of a rotary sleeve in Fig. 12.

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yang. The Examiner acknowledges that Yang is silent in regard to the configuration of the slotted portion 5-1. The Examiner, thus, contends that one skilled in the art would have been motivated to provide the slot 5-1 of Yang with a tapered shape.

In further regard to claim 13, the Examiner contends that it would have been a matter of "design choice" to provide Yang with the tapered surface. However, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Examiner cannot substitute an assertion of "design choice" for the required "factual basis," when considering a physical element with characteristics not taught or suggested by the art. The prior art must provide one of ordinary skill in the art with the motivation to make the proposed modifications needed to arrive at the claimed slotted portion. The art does not provide this motivation.

Claims 11, 12 and 13 are patentable over the applied references due to their respective dependencies upon claim 1 and their individual recitations. The features of claim 1, upon which claims 11, 12 and 13 depend, are not taught nor suggested by the combinations of 1) Yang and Owens; and 2) Yang and Sakamaki.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 10/727,531

ATTORNEY DOCKET: Q78334

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Daniel V. Williams
Registration No. 45,221

Date: August 28, 2006